



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,766	09/15/2003	Robert Kindermann	449122064200	7271

25227 7590 06/14/2007
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

EXAMINER

IBRAHIM, MOHAMED

ART UNIT	PAPER NUMBER
----------	--------------

2144

MAIL DATE	DELIVERY MODE
-----------	---------------

06/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,766

Applicant(s)

KINDERMANN, ROBERT

Examiner

Mohamed Ibrahim

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities: Last line of claim two recites the phrase "object OBJ." Applicant is asked to either place parenthesis around "OBJ" or completely remove it from the claim for consistency purposes. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear to the Examiner what exactly the Applicant is claiming with this phrase "transferring the object to the first subscriber and stored on the computer."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimoosawa, U. S. Patent No. 6658456.

Regarding claim 1, Shimoosawa discloses a method for establishing a connection between a first and a second subscriber of a telecommunications network (see e.g. fig. 6 and col. 4 lines 3-8; a public switched telephone network), comprising: creating an object intended for use on a computer (see e.g. col. 1 lines 57-61; sending an e-mail); inserting an address assigned to the second subscriber in the telecommunications network (see e.g. col. 4 lines 57-65; e-mail address is required in order to compose emails); transferring the object to the first subscriber and stored the computer (see e.g. col. 8 lines 22-33; e-mail transmission and storage units are provided); reading out, with aid of a function which is activated by the first subscriber, the address assigned to the second subscriber in the telecommunications network (see e.g. col. 10 lines 3-4; received e-mail is activated or read); and establishing the connection between first and second subscriber with aid of the address, wherein the address assigned to the second subscriber in the telecommunications network is added as an attribute to the content of the object and is read out (see e.g. col. 5 lines 20-44; the transfer determination unit carries out a matching in the transfer management table for the e-mail address which the received e-mail from the sender was destined).

Claim 2 is substantially the same as claim 1 and is thus rejected for reasons similar to those in rejecting claim 1. Furthermore Shimoosawa discloses determining with aid of a

Art Unit: 2144

function which is activated by the subscriber, the address assigned to the second subscriber in the telecommunication network using the identification included in the object (see e.g. col. 5 lines 39-63).

Regarding claim 3, Shimoosawa discloses wherein the identification included in the attribute of the object is transferred in the telecommunications network using the function activated by the first subscriber, the address of the second subscriber is determined based on the identification and the connection to the second subscriber is established (see e.g. col. 6 lines 25-37).

Regarding claim 4, Shimoosawa wherein an e-mail is provided as the object, an e-mail address of the second subscriber is included as the identification, and the address of the second subscriber in the telecommunications network is determined based on the e-mail address (see e.g. col. 5 lines 20-28 and col. 6 lines 17-23).

Regarding claim 5, the limitation of claim 5 is substantially same as that of claim 1 and thus is rejected for reasons similar to that on claim 1.

Claim 6 list some the same elements of claim 1, but in computer form rather than method form. Therefore, the supporting rationale of the rejection to claim 1 applies equally as well to claim 6.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed Ibrahim whose telephone number is 571-270-1132. The examiner can normally be reached on Monday through Friday from 7:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn, Jr. can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/661,766
Art Unit: 2144

Page 6

/MI/ *me*

WCVg
WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100